

REMARKS/ARGUMENTS

I. Telephonic Interview with Examiner Widhalm on January 22, 2008

Applicants (hereinafter referred to as "Petitioners") thank Examiner Angela M. Widhalm for the courtesy extended to Petitioners' representative during the January 22, 2008 telephonic interview. During the teleconference, Petitioners' representative discussed with the Examiner reasons why the Notice of Abandonment mailed on January 11, 2008 was not proper in this case. The Examiner indicated during the interview that a petition was required to be filed in this case. The substance of the interview, as well as additional reasons why issuance of the Notice of Abandonment in this case was improper, is summarized in the remarks of Section II, which follows below.

II. Application is Not in Fact Abandoned

Petitioners respectfully request withdrawal of the holding of abandonment in this case. The basis of this request is that the application is not in fact abandoned because there is disagreement as to controlling dates. The Manual of Patent Examining Procedure (MPEP) § 711.03(c)(I) states, "Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under **37 CFR 1.181(a)** requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee."

The Notice of Abandonment dated January 11, 2008 states, "This application is abandoned in view of: Applicant's failure to timely file a proper reply to the Office letter mailed on 14 September 2007." The "Office letter" referred to in the Notice of Abandonment is an Interview Summary dated September 14, 2007. The Interview Summary states, "If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW." In other words, a reply to the interview summary was not mandatory. In addition, if, for the sake of argument, a reply was required to be filed, the reply would only require "a statement on the substance of the interview." The Interview Summary dated September 14, 2007 set no other time requirements for

filing any other type of reply, such as a 1-month time limit to rewrite dependent claims in independent form in accordance with MPEP § 1214.06.

Further, the Notice of Abandonment dated January 11, 2008 states, “Examiner and applicant’s representative conducted an interview on 18 July 2007 discussing the decision by the Board of Patent Appeals and Interference rendered on 30 May 2007. Applicant’s representative declined an examiner’s amendment to put dependent claims 5 and 9 in independent form. The time period to reply has expired and no reply has been received, so the application is now abandoned.”

Section 1214.06 of the MPEP states:

If the Board or court affirms a rejection against an independent claim and reverses all rejections against a claim dependent thereon, ** after expiration of the period for further appeal, >the examiner< should proceed in one of two ways:

- (1) Convert the dependent claim into independent form by examiner’s amendment, cancel all claims in which the rejection was affirmed, and issue the application; or
- (2) Set a 1-month time limit in which appellant may rewrite the dependent claim(s) in independent form. Extensions of time under **37 CFR 1.136(a)** will not be permitted. If no timely reply is received, the examiner will cancel all rejected and objected to claims and issue the application with the allowed claims only.

In this case, the Board of Patent Appeals and Interferences in the Decision on Appeal reversed all rejections against dependent claims 5 and 9. Decision on Appeal dated May 30, 2007, page 7, ORDER. As a result, in accordance with MPEP § 1214.06, the Examiner, after expiration of the period for further appeal, should have converted dependent claims 5 and 9 into independent form by Examiner’s Amendment, canceled all claims in which the rejection was affirmed, and issued the application or set a 1-month time limit in which Petitioners could rewrite the dependent claims in independent form. After the expiration of the period for further appeal from the Board’s decision, the Examiner neither converted dependent claims 5 and 9 into independent form by Examiner’s Amendment nor set a 1-month time limit to allow Petitioners to rewrite dependent claims 5 and 9 in independent form as required by MPEP § 1214.06.

The Examiner states, “Applicant’s representative declined an examiner’s amendment to put dependent claims 5 and 9 in independent form” during the interview conducted on July 18, 2007. Notice of Abandonment dated January 11, 2008. However, it should be noted that the interview

was conducted prior to the expiration of the period for further appeal. Section 1216 of the MPEP states, “The time for filing a notice of a **35 U.S.C. 141** appeal to the Federal Circuit or for commencing a civil action under **35 U.S.C. 145** ** is within 2 months of the Board's decision. **37 CFR 1.304(a).**” Consequently, because the Decision on Appeal was issued on May 30, 2007, Petitioners had until July 30, 2007 in which to file an appeal of the Board's decision in this case.

As a result, Petitioners' representative declined the Examiner's Amendment to put dependent claims 5 and 9 in independent form during the interview conducted on July 18, 2007 because at the time the interview was conducted Petitioners' representative had not received any instructions from the Petitioners regarding a possible appeal of the Board's decision. Instead, during the interview Petitioners' representative requested that the Examiner issue an Office Action setting the 1-month time limit in which Petitioners could rewrite dependent claims 5 and 9 in independent form. This request was based on allowing Petitioners' representative time to receive instructions from the Petitioners regarding an appeal of the Board's decision. Also, it was Petitioners' representative understanding after the interview conducted on July 20, 2007 that the Examiner would issue an Office Action setting the 1-month time limit to rewrite the dependent claims in independent form (see evidence attachment). The evidence that is attached to this petition is a copy of the note Petitioner's representative prepared for the file immediately following the interview conducted on July 20, 2007.

However, no such Office Action setting the 1-month time limit to rewrite the dependent claims in independent form in accordance with MPEP § 1214.06 was issued by the Examiner. Instead, the Examiner issued an Interview Summary dated September 14, 2007, which only set a 1-month date in which to “file a statement on the substance of the interview.” Accordingly, Petitioners respectfully submit that the time period to file a proper reply has not expired because a time limit to rewrite dependent claim 5 and 9 in independent form was never set by the Examiner. Hence, the issuance of the Notice of Abandonment in this case was improper.

III. Conclusion

In consideration of these submissions, it is respectfully requested that the holding of abandonment be withdrawn.

Date: January 25, 2008

Respectfully submitted,

/Peter B. Manzo/

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